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10/786,023	02/26/2004	Franco Modigliani	056105-5002	2925
9629 7590 02/12/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER NGUYEN, HIEP VAN				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,023

Applicant(s)

MODIGLIANI ET AL.

Examiner

HIEP NGUYEN

Art Unit

4137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date 10/26/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-30 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 and 25-28 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claims 1 and 25 are directed to a system that does not have a tangible means. The Examiner respectfully suggests (and assuming Applicants' original specification supports such an amendment) adding into the body of the claim a computer or other structure.

- b. Claims 2-11 and 26-28 are also rejected as each depends from either claim 1 or claim 25.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claims 1 the limitation "publicly available" in the claim does not change the structure of the systems of claim 1 and 25, nor does it effect the method of claim 12. Therefore the scope of claim 1, 12, and 25 is unclear to a person of ordinary skill in the art (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 3-5, 7, 10, 16, 18, 19, 21, and 23 are also rejected as each recites similar language.

b. Claim 2-11, 13-24 and 26-30 are also rejected as each depends from either claim 1, 2, 5, 12, 16, 19, 23 or 25.

c. In claim 5, the limitation "the directory is adapted to make deposits" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can make a deposit.

d. In claim 6, the limitation "the directory is adapted to withdraw funds" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can withdraw funds.

e. In claim 16, the limitation "the directory is adapted to withdraw funds" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can withdraw funds.

- f. In claim 17, the limitation "the directory makes deposits" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can make a deposit.
 - g. In claim 26, the limitation "the root directory is adapted to make deposits" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can make a deposit.
 - h. In claim 27, the limitation "the directory is adapted to withdraw funds" in line 1 is indefinite because a person of ordinary skill in the art would not know how a "directory" can withdraw funds.
2. Claim 27 recites the limitation "the directory" in line 1 of the claim. Claim 26 defines the "root directory" for the system of claim 25. There is insufficient antecedent basis for this limitation. Examiner notes that "the directory" is intended for "the root directory."
3. Claim 29 recites the limitation "the accounts" in line 1 of the claim. There is insufficient antecedent basis for this limitation of claim. Because the letter "s" of "the accounts" yet none is found in claim 1. The Examiner respectfully recommends changing "accounts" to "account."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim1 is rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (U.S. 6,173,272).
6. With respect to claim 1, Thomas et al. teaches a system for conducting financial transactions, comprising: an account residing at a financial institution; and a unique identifier linked to an account holder, the unique identifier being publicly available; wherein the account receives deposits using the unique identifier (Abstract, Col. 5, lines 15-30.)
7. With respect to claim 2, Thomas et al. teaches the system of claim 1, further comprising at least one directory for associating the account holder with the unique identifier (Col. 4, lines 37-42, Col 8, lines 24-30, Col 10, lines 4-12.)
8. With respect to claim 3, Thomas et al. teaches the system of claim 2, wherein the directory functions as a root directory for synchronizing content with other directories containing a plurality of unique identifiers associated with a plurality of accounts residing at a plurality of financial institutions (Col. 5, lines 15-34, Col 10, lines 12-24.)
9. With respect to claim 4, Thomas et al. teaches the system of claim 2, wherein the directory associates the account holder with the financial institution (Col. 4, lines 43-48, Col 8, lines 23-34.)
10. With respect to claim 5, Thomas et al. teaches the system of claim 2, wherein the directory is adapted to make deposits directly to the account (Col. 10, lines 12-24.)

11. With respect to claim 6, Thomas et al. teaches the system of claim 5, wherein the directory is adapted to withdraw funds from a depositor's account and deposit the funds directly into the account (Col 5, lines 15-34, Col 10, lines 12-24.)

12. With respect to claim 8, Thomas et al. teaches the system of claim 1, wherein the account is linked to a standard financial account (Col. 5, lines 15-30.)

13. With respect to claim 9, Thomas et al. teaches the system of claim 8, wherein funds are transferred automatically from the account to the standard financial account (Col. 5, lines 45-55.)

14. With respect to claim 11, Thomas et al. teaches the system of claim 1, wherein funds are deposited into the account from a merchant or service provider that accepts payment with a credit card (Col. 6, lines 26-35.)

15. With respect to claim 12, Thomas et al. teaches a method of conducting a financial transaction, comprising the steps of: providing a payer with a unique identifier that is publicly available; directing the payer to an account residing at a financial institution, the account being associated with the unique identifier; and depositing funds into the account using the unique identifier (Col. 5, lines 35-56.)

16. With respect to claim 13, Thomas et al. teaches the method of claim 12, further comprising the step of directing the payer to the financial institution where the account resides (Col. 5., lines 58-67.)

17. With respect to claim 14, Thomas et al. teaches the method of claim 12, further comprising the step of providing a real-time confirmation of the financial transaction (Col. 10, lines 52-57.)

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18. With respect to claim 15, Thomas et al. teaches the method of claim 12, further comprising the step of providing a directory for directing the payer to at least one of the account and the financial institution (Col. 4, lines 5-15.)

19. With respect to claim 16, Thomas et al. teaches the method of claim 15, wherein the directory is adapted to withdraw funds from a payer's account (Col 5, lines 15-34, Col 10, lines 12-24.)

20. With respect to claim 17, Thomas et al. teaches the method of claim 16, wherein the directory makes deposits directly from the payer's account to the account (Col. 10, lines 12-24.)

21. With respect to claim 19, Thomas et al. teaches the method of claim 12, wherein the account is linked to a standard financial account (Col. 5, lines 35-55.)

22. With respect to claim 20, Thomas et al. teaches the method of claim 19, wherein the funds are transferred automatically to the standard financial account (Col. 5, lines 45-55.)

23. With respect to claim 22, Thomas et al. teaches the method of claim 12, wherein funds are deposited into the account from a merchant or service provider that accepts payment with a credit card (Col. 7, lines 66-67, Col. 8, lines 1-4.)

24. With respect to claim 23, Thomas et al. teaches the method of claim 12, wherein the account is linked to more than one standard financial account (Col. 5, lines 35-55.)

25. With respect to claim 24, Thomas et al. teaches the method of claim 23, further comprising the step of providing real-time confirmation of a financial transaction to more than one standard financial account (Col. 10, lines 52-57.)

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26. With respect to claim 25, Thomas et al. teaches a system for conducting financial transactions, comprising: a plurality of accounts residing at a plurality of financial institutions, each of the accounts having a unique identifier linking an account holder with the account, the unique identifiers being publicly available; a plurality of directories providing the unique identifier for an account holder; and a root directory for synchronizing information contained in the plurality of directories (Col. 5, lines 15-34.)

27. With respect to claim 26, Thomas et al. teaches the system of claim 25, wherein the root directory is adapted to make deposits into the plurality of accounts (Col. 10, lines 12-24, Col. 16, lines 46-54.)

28. With respect to claim 27, Thomas et al. teaches the system of claim 26, wherein the directory is adapted to withdraw funds from a depositor's account and deposit the funds directly into the plurality of accounts (Col 5, lines 15-34, Col 10, lines 12-24.)

29. With respect to claim 28, Thomas et al. teaches the system of claim 25, wherein the accounts are deposit-only accounts (Col. 10, lines 12-24.)

30. With respect to claim 29, Thomas et al. teaches the system of claim 1, wherein the accounts are deposit-only accounts (Col. 10, lines 12-24.)

31. With respect to claim 30, Thomas et al. teaches the method of claim 12, wherein the account is a deposit-only account (Col 10, lines 12-24.)

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claim1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Diveley et al. (U.S. 7,165,052.)

34. With respect to claim 1, Thomas et al. teaches the limitations using a universal identifier. However, Thomas et al. does not directly show the unique identifier. Diveley et al. teaches the unique identifier (col. 1, lines 62-64, col. 3, lines 22-25.) Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thomas et al. as taught by Diveley and include Diveley's unique identifier in Thomas et al.

35. With respect to claims 7, 10, 18, and 21, Thomas et al. does not disclose the limitations using a credit card provider. However, Diveley et al. teaches the credit card provider (Col. 1, lines12-20, Col. 2, lines 30-33.) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thomas et al. as taught by Diveley and include Diveley's credit card provider in Thomas et al.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomas et al. (U.S. 6,173,272) teaches the universal identifier; Diveley et al. (U.S. 7,165,052) teaches the unique identifier and a credit card provider.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571)270-5211. The examiner can normally be reached on Monday through Thursday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L Hewitt can be reached on 5712726709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/H. N./

Examiner, Art Unit 4137

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 4137